

REMARKS:

The Office Action dated September 13, 2006, has been carefully considered. In response thereto, the present paper, which is believed to be fully responsive to that Office Action, has been prepared.

Status of the Claims

Claims 1-7 and 10 are pending in the application. Claims 8 and 9 and 11-53 were previously cancelled in response to a restriction requirement without prejudice to Applicants' right to re-file those claims in one or more continuation (divisional) applications. Claims 54 and 55 are new and are being submitted herewith. Thus, upon entry of this paper in the record, claims 1-7, 10, 54 and 55 will be pending in the application.

Summary of the September 13, 2006, Office Action

In the Office Action, the Examiner has acknowledged Applicants' election of claims 1-7 and 10 for prosecution on the merits. The Examiner notes that an Information Disclosure Statement (IDS) submitted on April 28, 2004, did not include copies of each foreign patent document or other information identified on page 1 of the Detailed Action. Claims 1-5 and 7 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1-7 and 10 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,208,893 to *Hofmann*. The following remarks are intended to address each of the rejections rejections.

Information Disclosure Statement

The Examiner has crossed-through references AY and AZ on Applicants' April 28, 2004, IDS because copies of the cited references were not provided. Applicants will provide the references to the Examiner for his consideration as soon as copies are obtained.

Rejections of Claims Under 35 U.S.C. § 112, Second Paragraph

Claims 1-5 and 7 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because, in claim 1 (from which claims 2-5 and 7 depend), the language “to removably receive...at least part of the second segment in contact with the electrically conductive portion” is allegedly vague and seems to be missing several words. The Examiner suggest deleting the “in contact...portion” language or inserting language similar to claim 6. Applicants have amended claim 1 to remove the problematic language.

Claims 5 and 7 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because it is allegedly unclear in what direction, axis, and/or orientation the claimed “spaced apart” term is referring. Applicants have amended claim 1 (from which claim 5 depends) to remove the problematic “spaced apart” language.

With regard to claim 7, Applicants respectfully disagree with the Examiner’s contentions regarding the “spaced apart” term. It is well settled that claims in an application need only define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity. *Ex parte Ohsumi*, 21 U.S.P.Q.2d 1020,1024 (Bd. Pat. App. & Int. 1991). In the present case, claim 7, read in the context of the entire claim (and claims from which it depends), and viewed in the context of the specification (including the figures), would allow a person skilled in the art to understand that the term “spaced apart” refers to the relative movement of the first and second segments when they are physically moved relative to each other during operation of the device. It is submitted that the claims do not have to recite precisely how that movement occurs to satisfy the § 112, second paragraph, requirement.

Reconsideration and withdrawal of the rejection of the claims under § 112, second paragraph, are requested.

Rejections of Claims Under 35 U.S.C. § 102(b)

Claims 1-7 and 10 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,208,893 to *Hofmann*. In particular, the Examiner contends that the *Hofmann* patent discloses each and every feature of the claimed invention. For the following reasons, Applicants respectfully traverse the Examiner’s rejection.

Independent claims 1, 6, and 10 have been amended to specify that the elongated percutaneous electrode is contained entirely within a coupling member when in a first neutral position and is “movable relative to the coupling member and deployable from a first neutral position to a second position” (the second position being when the electrode is inserted into a patient during use). It is submitted that the electrodes 152 disclosed in the *Hofmann* patent (Fig. 23) are selectively extendable through a plurality of bores for injection of an agent into tissue, but not deployable from a first neutral position to a second position (percutaneous penetration). Thus, the *Hofmann* patent does not disclose every feature recited in claims 1, 6, or 10 (or in claims 2-5, and 7, which depend from claims 1 and 6, respectfully).

For those reasons, reconsideration and withdrawal of the rejection of the claims under § 102(b) are requested.

New Claims

Claims 54 and 55 recite that the conductive member has an approximately J-shaped conductive member. Support for those claims is contained in FIG. 33 of the application and the accompanying text in paragraph [00147] of the as-filed application. Thus, no new matter is being added. Entry of those claims in the record is requested.